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09/710,343	11/09/2000	John G. Savage	8879.00	5052

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EXAMINER.

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,343

Applicant(s)

SAVAGE ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/20/03 have been fully considered but they are not persuasive.

In reference to the Applicant's argument that "the motivation to combine and/or modify the reference is supplied by the Office Action rather than the references themselves", the Examiner submits that a reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969). Also, *Stevens* states that, "While the preferred embodiments of the present invention have been shown and described, it is to be understood that various modifications and changes could be made thereto without departing from the scope of the appended claims. The *Stevens* reference further describes an invention that "... is to provide the hardware, software, firmware, middleware, and other support including a network to develop bonded relationships across channels with participating businesses and consumers."

In reference to the Applicant's discussion of the concepts presented by each of the references, the Examiner submits that one cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references. *In re Young*, 159 USPQ 725 (CCPA 1968).

Claims 1-5, 7-13 and 15-17 are presently pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "defining a communications port" in claim 9 is a relative term which renders the claim indefinite. The term "defining a communications port" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,7,8,10-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randall et al. GB 2,137,401 [Randall '401, and further in view of Leroux US 5,588,146 [Leroux '146] and Stevens US 6,327,570 B1 [Stevens '570].

As per claim 1:

Randall '401 discloses:

a communications port: Fig. 1, **25**

Randall '401 discloses the claimed invention except for the transfer of software for execution on a portable device from the terminal to the portable device using the communications port. However, Randall '401 does teach about the transfer of software to a portable device, i.e. memory modules, lines 15-34, that then can be used in a microprocessor remote to the terminal. Leroux '146 teaches that it is known in the art to provide a portable device that is a microprocessor. (Abstract-last line). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the software vending system of Randall '401 with the ability to communicate with a portable microprocessor of Leroux '146, in order to increase the availability and use of the software programs to prospective customers.

Randall '401 and Leroux '146 teaches all of the elements claimed with the exception of wherein the software is operable on the portable device to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to (be) executed by a

self service terminal. Randall '401 discloses that the software may be a video game, an educational or business program. Pg. 4, lines 22-25.

Stevens '570 teaches that it is known in the art to provide wherein the software is operable to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to be executed by a self service terminal. Col. 9-10, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of vending software of Randall '401 with the wherein the software is operable to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to be executed by a self service terminal of Stevens '570, in order to increase the power and flexibility of the system to promote customer participation and greater sales.

As per claims 2 and 10:

Randall '401 further discloses the claimed invention except for the communications port comprises a wireless port. However, Randall '401 does disclose an interconnecting communications line. (Fig. 1, **25**) Leroux '146 teaches that it is known in the art to provide a wireless communications port. (Fig. 1, **3**) It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the interconnecting communications line of Randall '401, with the wireless capabilities of Leroux '146, in order to increase the flexibility/options of where the central

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processing unit could be located to provide greater exposure/availability to prospective customers.

As per claims 3 and 11:

Randall '401 further discloses:

further comprising (i) means for connecting to a host, and (ii) means for receiving software from a host for transferring to a portable device. Fig. 1, 25.

As per claims 4 and 12:

Claim 4 is rejected under 35 U.S.C. 103 as being unpatentable over Randall '401 and Leroux '146. Randall '401 and Leroux '146 teaches all of the elements claimed with the exception of wherein the software relates to a financial service and includes parameters that are correct at the time the software is transferred.

The examiner takes Official Notice that the software provided could in fact be software that relates to a financial service and includes parameters that are correct at the time the software is transferred.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of wherein the software provided is software relating to a financial service and includes parameters that are correct at the time the software is transferred because the skilled artisan would have recognized that this business practice of providing software that relates to a financial service and includes

parameters that are correct at the time the software is transferred is well known and is clearly applicable to the system of vending software.

The references do not expressly show the where the software relates to a financial service.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The transfer of the software for execution on a portable device would be performed the same regardless of the type of software that was involved. i.e. financial, game, etc. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide software for financial transaction or other type of programs because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 7 and 16:

Randall '401 discloses the claimed invention as per Claim 1 rejection except for a plurality of self-service terminals. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have a plurality of self-service terminals, since it has been held that mere duplication of the essential working parts of

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a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Randall '401 and Leroux '146 teaches all of the elements claimed with the exception of wherein the software is operable on the portable device to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to (be) executed by a self service terminal. Randall '401 discloses that the software may be a video game, an educational or business program. Pg. 4, lines 22-25.

Stevens '570 teaches that it is known in the art to provide wherein the software is operable to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to be executed by a self service terminal. Col. 9-10, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of vending software of Randall '401 with the wherein the software is operable to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to be executed by a self service terminal of Stevens '570, in order to increase the power and flexibility of the system to promote customer participation and greater sales.

As per claims 8 and 17:

Randall '401 discloses:

providing a software program at a central location; Fig. 1.

Randall '401 discloses the claimed invention except for the transferring the software program to one or more terminals using a network connection; and in response to a request from a user, transferring the software program to a portable device presented to a terminal by the user.

However, Randall '401 does teach about the transfer of software to a portable device, i.e. memory modules, lines 15-34, that then can be used in a microprocessor remote to the terminal. Leroux '146 teaches that it is known in the art to provide a portable device that is a microprocessor. (Abstract-last line). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the software vending system of Randall '401 with the ability to communicate with a portable microprocessor of Leroux '146, in order to increase the availability and use of the software programs to prospective customers.

Randall '401 and Leroux '146 teaches all of the elements claimed with the exception of wherein the software is operable on the portable device to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to (be) executed by a self service terminal. Randall '401 discloses that the software may be a video game, an educational or business program. Pg. 4, lines 22-25.

Stevens '570 teaches that it is known in the art to provide wherein the software is operable to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to be executed by a self service terminal. Col. 9-10, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of vending software of Randall '401 with the wherein the software is operable to receive details from a user and to prepare a response program for transmitting back to a self-service terminal, the response program including details of a transaction to be executed by a self service terminal of Stevens '570, in order to increase the power and flexibility of the system to promote customer participation and greater sales.

As per claim 15:

Randall '401 further discloses:

means for receiving payment from a user for the transferred software. Fig. 3, 7.

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Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randall '401 and Leroux '146. Randall '401 and Leroux '146 as applied to claims 1-4 above, and further in view of Morales US 5,291,554 [Morales '554]

As per claims 5 and 13:

Randall '401 and Leroux '146 discloses the claimed invention except for wherein the software has a time to live, so that once the time to live has expired the software automatically deletes itself. However, Leroux '146 teaches about the self-protection of remote loaded software programs. Col. 3, lines 23-30.

Morales '554 teach that it is known in the art to wherein the software has a time to live; so that once the time to live has expired the software automatically deletes itself. Col. 3, lines 15-25.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the self-protection system of Randall '401 and Leroux '146 with the self destruct feature of Morales '554, in order to provide another way of protecting the licensing rights of the producer/author and simplify the control of the software by not having to monitor the usage.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

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may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

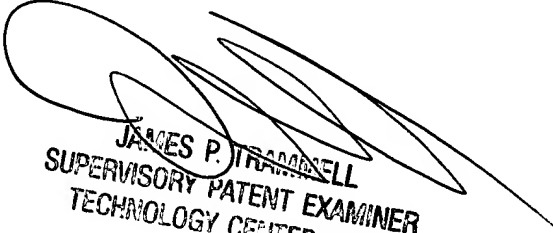
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DLG
January 6, 2004


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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